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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,150	02/11/2004	Joshua A. Gerak	PL050021	2149

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EXAMINER

WONG, STEVEN B

ART UNIT PAPER NUMBER

3711

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,150	Applicant(s) GERAK ET AL. 617	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15 is/are allowed.
- 6) ☒ Claim(s) 16-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>feb 11 2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19, 20, 25 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 19, 20 and 29, the language “or like image” is indefinite as it is not clear how the images other than the message, logo, slogan or advertisement has to resemble the message, logo, slogan or advertisement to satisfy the limitations of the claim. See MPEP 2173.05(b)(F).

Claim 25 is indefinite as it is unclear what limitations of the claim are being set forth in the method. Claim 25 depends from claim 21 and claim 21 is seen as a product-by-process claim (see MPEP 2113) where the intermediate steps are not structural limitations of the claim. However, claim 25 is a method claim and appears to only refer to the end product of claim 21 by stating “of the spherical crocheted object of claim 21”. Thus, it appears that claim 25 is relying on the method steps recited only in claim 25 and relies on the end product of claim 21 (the spherical crocheted object of substantially spherical shape with an embroidered portion embroidered thereon).

Claims 27 and 28 are indefinite as they refer to claim 26 as a method claim or state “using the steps of claim 26”, however claim 26 is an apparatus claim without any recited steps.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bissell (660,787) in view of Ellis (2,399,478), Contini (6,067,660) and Conrad (3,662,878). Regarding claims 16 and 17, Bissell discloses a tether ball construction including a crocheted ball covering (3) of spherical shape. However, Bissell lacks the teaching for an embroidered portion on the crocheted surface.

Ellis reveals that it is well known in the art of crocheting to stitch a patch (13-16) within the crocheted portion (10) for ornamental purposes. It would have been obvious to one of ordinary skill in the art to apply a patch in the ball of Bissell in order to make the ball cover more aesthetically appealing. However, the combination of Bissell in view of Ellis lacks the teaching for the patch to be embroidered to the crochet portion.

Contini reveals that it is well known in the art to apply a layer (18) to a substrate by sewing or embroidery (column 3, lines 14-18). It would have been obvious to one of ordinary skill in the art to use embroider the patch of Ellis to the crocheted ball of Bissell in order to provide an alternative method for attaching the patch that is taught by Contini as being substantially equivalent. However, the combination of Bissell in view of Ellis and Contini lack the teaching for the patch to be embroidered.

Conrad simply reveals that it is well known in the art of patches to form the patch by embroidery. It would have been obvious to one of ordinary skill in the art to form the patch of Ellis from embroidery as taught by Conrad in order to provide a more aesthetically appealing patch.

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It would have been obvious to one of ordinary skill in the art to form the patch on the ball of Bissell with a diameter no greater than about 30% of the circumference of the spherical shape in order to provide a small advertisement on the ball that is not obtrusive.

Regarding claim 18, it would have been obvious to one of ordinary skill in the art to form the embroidered portion with a diameter of no more than 2.25 inches in order to provide a smaller advertisement on the ball that is not obtrusive. It would have been obvious to one of ordinary skill in the art to form the ball of Bissell with a circumference of 7.5 inches in order to allow the cushioned ball to be used for other sports or activities.

Regarding claims 19 and 20, it would have been obvious to one of ordinary skill in the art to provide the patch of Ellis as modified by Conrad with a logo, slogan or advertisement thereon in order to advertise a particular manufacturer or endorser.

Regarding claim 21, the claim is a product-by-process claim where patentability is based only on the end product itself. See MPEP 2113. The combination of Bissell in view of Ellis, Contini and Conrad provide a ball with a embroidered portion that is embroidered onto the ball. The claim language describing the initial disc and additional rows added to the initial disc do not distinguish the instant ball from that of the prior art because the end product in both the prior art and the instant invention is a ball with an embroidered portion embroidered thereon.

Regarding claim 22, it would have been obvious to one of ordinary skill in the art to form additional rows that form around 36% to around 46% of the ball in order to manufacture a ball of a particular size and for a particular sport or activity.

Regarding claim 23, the claim is a product-by-process claim where the patentability is based only on the end product itself. Here, the end product is a crocheted

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ball comprising an embroidered portion embroidered onto a crocheted surface of the ball.

This structure is taught by the combination of Bissell in view of Ellis, Contini and Conrad as set forth in the rejection of claim 16.

Regarding claim 24, neither claim 24 nor claim 16 recite any particular method steps for manufacturing the ball. Therefore, the combination of Bissell in view of Ellis, Contini and Conrad render the claim obvious by teaching the claimed structure.

Regarding claim 25, insofar as this claim may be understood, the combination of Bissell in view of Ellis, Contini and Conrad render the claim obvious by providing a spherical crocheted ball having an embroidered portion embroidered thereon. Like claim 24, claim 25 is not seen as setting forth any method steps for manufacturing the ball.

Regarding claims 26 and 27, note the rejection of claim 16.

Regarding claims 28 and 29, note the rejection of claims 19 and 20.

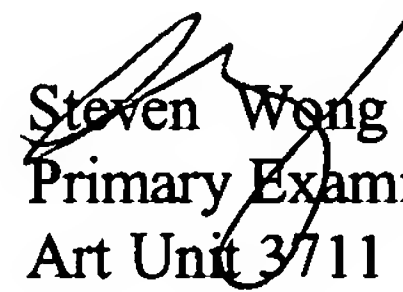
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
March 31, 2005